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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,824	11/06/2000	Horst Loerz	514413-3848	5275

7590 07/17/2002
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EXAMINER

CHEN, SHIN LIN

ART UNIT PAPER NUMBER

1632

DATE MAILED: 07/17/2002 10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/674,824

Applicant(s)

LOERZ ET AL.

Examiner

Shin-Lin Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-6, 8-12 and 14-16, drawn to a nucleic acid molecule encoding a protein comprising the amino acid sequence of SEQ ID No. 2, a nucleic acid molecule comprising the nucleotide sequence of SEQ ID No. 1 or a part thereof, and a nucleic acid molecule which hybridizes with the nucleic acid molecules set forth above, a vector containing said nucleic acid molecule, a host cell containing said vector, and a process for the preparation of a protein.

Group II, claim(s) 7, drawn to a nucleic acid molecule which hybridizes with the nucleic acid molecule of claim 1 and is an oligonucleotide with a length of at least 15 nucleotides.

Group III, claim(s) 13, drawn to a protein encoded by a nucleic acid molecule of claim 1.

Group IV, claim(s) 17-23, drawn to a process for generating a transgenic plant cell, a plant containing said transgenic plant cell, and propagation material of said plant.

Group V, claim(s) 24-26, drawn to starch obtainable from the plant set forth above, and the use of the starch.

2. The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special

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technical features for the following reasons: The technical feature shared by groups I-V is the nucleic acid molecule in group I, i.e. a nucleic acid molecule encoding a protein comprising the amino acid sequence of SEQ ID No. 2, a nucleic acid molecule comprising the nucleotide sequence of SEQ ID No. 1 or a part thereof, or a nucleic acid molecule which hybridizes with the nucleic acid molecules set forth above. Block et al. (1996) discloses a *Triticum aestivum* soluble starch synthase cDNA sequence, GenEmbl Accession No. U48227, which is 100% identical to base 718 to 2271 of SEQ ID No. 1, and therefore contains a part of SEQ ID No. 1 and will hybridize to SEQ ID No. 1. Thus, no special technical feature is contributed over the prior art by the present application. An oligonucleotide can be used as a primer, however the nucleic acid molecule of claim 1 can be used to produce a protein. Therefore, an oligonucleotide and the nucleic acid molecule are different products having different uses. Further, a process for the preparation of a protein, a process for generating a transgenic plant cell, and the use of the starch are different methods that differ at least in their objectives, process steps, reagents and doses used, schedules used, and criteria of success. Thus, groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 .

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shin-Lin Chen whose telephone number is (703) 305-1678. The examiner can normally be reached on Monday to Friday from 9 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Priebe can be reached on (703) 308-7310. The fax phone number for this group is (703) 308-4242.

Questions of formal matters can be directed to the patent analyst, Patsy Zimmerman, whose telephone number is (703) 305-2758.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-0196.

Shin-Lin Chen, Ph.D.

